Supreme Court, U.S.
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(1)

No.

IN THE

Supreme Court of the United States

MARK BRUCKELMYER,

Petitioner,

v.

T.H.E. MACHINE COMPANY,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether the majority opinion of the Federal Circuit and its precedents, including *In re Wyer*, 655 F.2d 221 (C.C.P.A. 1981) have impermissibly rewritten 35 U.S.C. §§ 102 (a) & (b) for Congress, requiring that they be overruled.

Whether the Federal Circuit's interpretation of 35 U.S.C. §§ 102 (a) and (b) has so substantially departed from the intent of Congress as to require the intervention of this Court to establish a sound and stable legal rule.

LIST OF PARTIES

The parties in the proceeding before the Federal Circuit were Mark Bruckelmyer, Plaintiff-Appellant, Ground Heaters, Inc., Defendant, and T.H.E Machine Company, Defendant-Appellee. Plaintiff-Appellant Mark Bruckelmyer settled its case with Defendant Ground Heaters, Inc. and, therefore, Ground Heaters, Inc. no longer has an interest in the outcome of this petition.

RULE 29.6 STATEMENT

None of the parties has a parent corporation that is not listed as a party. No publicly held company owns 10% or more of the corporate party's stock.

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PETITION FOR WRIT OF CERTIORARI

Petitioner Mark Bruckelmyer respectfully prays for writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the Federal Circuit, with a dissent by Judge Linn, is precedential under Federal Circuit Rule 47.6 and is reported. *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374 (Fed. Cir. 2006). (1a.) The order of the Federal Circuit denying Petitioner Bruckelmyer's Petition for Rehearing and Rehearing En Banc, with a dissenting opinion by Judge Newman joined by Judge Linn, is reported at *Bruckelmyer v. Ground Heaters, Inc.*, 453 F.3d 1352 (Fed. Cir. 2006). (14a.) There are two decisions of the District Court involved in this appeal, neither of which is reported. (21a, 30a.) The decisions of the District Court were upheld by the Federal Circuit.

JURISDICTION

The Federal Circuit issued its decision on April 20, 2006. (1a.) Petitioner timely moved for rehearing and rehearing en banc, which the Federal Circuit denied on June 28, 2006. (14a.) Petitioner invokes the jurisdiction of this Court under 28 U.S.C. § 1254(1).

STATUTES INVOLVED

35 U.S.C. §§ 102 (a) & (b) read:
A person shall be entitled to a patent unless-

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public

use or on sale in this country, more than one year prior to the date of the application for patent in the United States ... .

STATEMENT OF THE CASE

The United States Patent and Trademark Office issued two patents to Mark Bruckelmyer in 1995 and 1996, after due examination. The patents disclose a method and apparatus for thawing frozen ground so that concrete poured over the ground can cure, by placing rubber hoses on the ground and circulating warm liquid through the hoses. The record in this case is devoid of any evidence that Bruckelmyer's process was known or used in the United States prior to the issuance of Bruckelmyer's patents. One of the original defendants in this matter, Ground Heaters, Inc. ("Ground Heaters"),[1] licensed the patents from Bruckelmyer and began to use the process. During a patent infringement lawsuit brought under the license agreement by Ground Heaters against the other defendant in this matter, T.H.E. Machine Company ("T.H.E. Machine"), Ground Heaters and T.H.E. Machine agreed that Bruckelmyer's patents were invalidated by prior art located in the Canadian Intellectual Property Office ("CIPO"). Ground Heaters dropped its suit against T.H.E. Machine, ceased paying royalties under the license, and Bruckelmyer subsequently sued both companies in the present patent infringement lawsuit.

The art which Ground Heaters and T.H.E. Machine relied upon consists of three scraps of paper which, in the entire world, exist only in the prosecution file in the CIPO relating to a patent application filed in 1982 in Canada by Norman Young. *See generally*, C.A. App. 596-625. They

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[1] A settlement of Bruckelmyer's patent infringement claims in this matter was reached with Ground Heaters, Inc. and they are no longer a party to this case.

consist of two handwritten drawings, Figures 3 and 4, and typewritten text relating to those drawings, all of which were part of Young's initial patent application. Mr. Young prosecuted his patent application pro se, as a result of which a number of things about the prosecution of the application as well as the condition of the prosecution file history (commonly referred to as the "file wrapper"), were unorthodox. One of those was the fact that during the prosecution, Mr. Young cancelled and withdrew virtually all of his original application, including the three pieces of paper at issue. Thus, they appeared nowhere in Canadian Patent 1,158,119 (the " '119 Patent") which was issued to Mr. Young in 1983, nor was there any reference to the three cancelled documents in the Patent.

In fact, there is no reference to the three cancelled documents anywhere in the world. Under the law in effect in Canada at the time, neither the contents of Young's application nor the file wrapper were published or made public until the patent issued. (C.A. App. 218-19.) Once the patent issued the file wrapper was "laid open," that is, any member of the public could go to the CIPO and examine the file. However, other than the issued patent which said nothing about the cancelled material (because it was cancelled), no abstract, notice, notation, index, or reference to Young's initial application, or to the existence of the invalidating material, was ever published anywhere in the world at any time.

The file wrapper for the '119 Patent is kept only at one place, in the CIPO in Hull, Quebec, Canada. The CIPO created a microfiche copy of the file, which is available for review only at their office, and the archived original can also be reviewed there by special arrangement. It is undisputed that to examine or review the file wrapper, one must go in person to the CIPO in Hull. It is not available, nor is any index or reference to its contents other than the issued patent available, online or in any other way.

The '119 Patent is entitled "Portable Construction Heating System" and describes a method of placing flexible hoses circulating warm liquid "in close proximity to objects of various shapes and configurations which would otherwise be difficult to heat." The patent includes drawings of hoses used to heat an elevated beam. However, the '119 Patent does not disclose any process or method for thawing frozen ground or for laying concrete over frozen ground. Young's material claiming to disclose a process or method for thawing frozen ground or for laying concrete over frozen ground was contained in the hand drawings and text that were cancelled during prosecution and were expressly withdrawn from examination at the CIPO by Young. They are not part of, nor are they disclosed in, the '119 Patent.

The majority of patents include catchall language suggesting possible further applications of the invention not otherwise disclosed or supported by the inventor. Young's '119 Patent contains such a catchall clause: "The system is suitable for applying heat to other subjects and is not necessarily confined to use in relation to concrete placement. Other typical uses are: heating water barrels, liquid propane storage tanks, thawing frozen ground, etc." (C.A. App. 656.) Notwithstanding the cryptic reference to "thawing frozen ground," the Patent made no disclosure of any methods for applying heat to such "other objects," or for thawing frozen ground. Such clauses represent nothing more than an attempt by the patentee to broaden the patent's scope to cover every possible permutation of the invention, "past, present and future, that might be found satisfactory to achieve the desired result... ." *See Slayter & Co. v. Stebbins-Anderson Co., Inc.*, 31 F.Supp. 96, 104 (D. Md. 1940). Catchall clauses are commonly unsupported by any disclosure of structure, but merely make "a number of suggestions which do not indicate how they can be carried out." *Schick Dry Shaver, Inc. v. Dictograph Prods. Co., Inc.*, 16 F.Supp. 936, 940 (E.D.N.Y. 1936).

The District Court held that because the '119 Patent and its application were available for public inspection at the CIPO in Hull more than one year prior to the Bruckelmyer Patents, the contents of the '119 file wrapper were a "printed publication" under 35 U.S.C. § 102 (a) & (b). (27a.) The jurisdiction of the District Court was invoked under 28 U.S.C. § 1331. The Court made clear that the mere existence of the material in the file wrapper was sufficient to make this determination in the absence of any other evidence of dissemination, publication, indexing, or referencing:

> The parties here agree that the contents of the file wrapper were available for public inspection at the Canadian Intellectual Property Office in Hull, Quebec, Canada. There is no contention that the contents of the file wrapper were disseminated more widely or in any other format. Nevertheless, the Court concludes that the contents of the file wrapper are sufficiently accessible to the relevant and interested public as to constitute a printed publication for purposes of § 102(b).

(27a-28a) (emphasis supplied.)

Bruckelmyer stipulated in the District Court that if the file wrapper for the Canadian '119 Patent is a printed publication, it would render the patents in suit invalid for obviousness. Based on this stipulation, the District Court granted Summary Judgment of Invalidity. (30a.)

The majority of the panel of the Federal Circuit agreed with the District Court on appeal. The panel majority relied on *In re Wyer*, 655 F.2d 221, 226 (C.C.P.A. 1981), in which an Australian patent application which was laid open for public inspection was found to be "publicly accessible" because an abstract of the application was published by the Australian patent office. However, the present case was different from *Wyer* in that here, there simply is no published

abstract or its equivalent. So the panel majority made the equivalent of a first baseman's reach for a throw just out of the grasp. Neither defendant had provided the District Court or the Federal Circuit with any evidence whatsoever as to whether the cryptic reference to "thawing frozen ground" in the '119 Patent, or the subject matter of the Patent itself, would have lead a reasonable patent searcher, or anyone else, to look further and examine the file wrapper for disclosure of a further invention neither disclosed nor claimed in the Patent itself. Although it is black letter law that a patent is presumed valid, and can be overcome only by clear and convincing evidence of invalidity, 35 U.S.C. § 282; *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 1281 (Fed. Cir. 2005), the Federal Circuit panel majority said that an issued patent such as the Canadian '119 Patent in this case, is "presumably more informative of the content of its application file than a mere abstract of the patent application." (9a.) It is clear from the panel opinion that the majority was not establishing a legal presumption, rather the opinion assumed what was not proven - that an issued Patent serves as notice of material in its file wrapper that was intentionally cancelled and not included in the Patent. On this basis, it upheld the District Court's view that the mere existence of the material in the file wrapper, without anything more, was sufficient to invalidate Bruckelmyer's U.S. Patents.

Judge Linn dissented from the panel majority's decision. He disagreed with the majority that it can be assumed a published patent serves as an abstract or index to cancelled matter in the underlying prosecution file history:

> [T]he printed text of an issued patent ... is not necessarily looked to as a summary or index of the underlying file history. ... researchers normally expect the text of printed patents to correspond to and be coextensive with the applications from which they have been

> issued. In that sense, the text of an issued patent does not generally serve to guide researchers to the file history for a more expansive disclosure of the described invention, and it certainly does not lead researchers to the file history for disclosure of subject matter not described in the issued text.

(11a-12a.) He concluded that, "[t]he fact that an additional drawing, disclosing additional structure, is present in the application file is a matter of sheer happenstance nowhere indicated in the issued patent." (*Id.*)

Bruckelmyer then filed a Combined Petition for Panel Rehearing and Rehearing En Banc, arguing that the panel opinion had strayed too far from the plain meaning of 35 U.S.C. § 102 (a) & (b). The Petition was denied without a majority opinion. (15a.) However, Judge Newman, joined by Judge Linn, issued a strong dissent. Judges Newman and Linn were of the view that "[t]his excised and unpublished and unreferenced material is not a 'printed publication,' no matter how generously that concept is defined." (16a.) Judge Newman succinctly summarized the facts as follows:

> The facts are not in dispute. The [Bruckelmyer] '085 and '301 patents were held invalid because of the existence of two drawings that were stored in the unpublished archive of an unrelated Canadian patent application by a different inventor. The drawings were cancelled from the Canadian application before the patent was granted, and are not referred to in the published Canadian patent. It is undisputed that these cancelled drawings are not available in any database or any library, and that no index, no catalog, no abstract suggests their existence or their content. It is not contested that the only way

> to obtain these drawings (although their existence was unknown) is to personally go to the Canadian Patent Office in Hull, Quebec, and ask to examine the file wrapper (the prosecution history) of this particular patent, which is entitled "Portable Construction Heating System". This is not the method for heating frozen ground in preparation for pouring concrete, which is the subject of the patent in suit. The only lead to this particular Canadian prosecution record, we are told, is to observe that the broad recitation in the Canadian patent that "other typical uses [of the invention] are ... thawing frozen ground," and then to travel to Quebec to examine the file wrapper to see if it might contain information that was deleted from the Canadian application before issuance. This excised and unpublished and unreferenced material is not a "printed publication," no matter how generously that concept is defined. This court improperly relies on it to invalidate the United States Patents here at issue.

(15a-16a.)

REASONS FOR GRANTING THE PETITION

A. The Federal Circuit Decision and Its Precedents Have Exceeded the Plain Meaning and the Legislative Intent of 35 U.S.C. §§ 102 (a) & (b).

The law concerning the "printed publication" rule of 35 U.S.C. §§ 102 (a) & (b) as presently applied by the Federal Courts stems from a single statement by its predecessor court, the Court of Customs and Patent Appeals,

which undertook to refashion the statutes for Congress in *In re Wyer*, 655 F.2d 221 (C.C.P.A. 1981):[2]

> The traditional dichotomy between "printing" and "publication" is no longer valid. Given the state of technology in document duplication, data storage, and data-retrieval systems, the "probability of dissemination" of an item very often has little to do with whether or not it is "printed" in the sense of that word when it was introduced into the patent statutes in 1836. In any event, interpretation of the words "printed" and "publication" to mean "probability of dissemination" and "public accessibility," respectively, now seems to render their use in the phrase "printed publication" somewhat redundant.

Id. at 226 (emphasis supplied).

In *Wyer*, the Court substituted judicial doctrine for the statutory language chosen by Congress. It established a new standard requiring mere "public accessibility" rather than that a document meet the "printed publication" standard set by Congress. Since *Wyer*, and in pursuit of an evolving judicial standard to govern when foreign prior art invalidates a U.S. Patent, the Courts have proceeded down a slippery slope ever further from the "printed publication" rule established by Congress. The standard established in the present case is simply whether it appears to be possible for a member of the public to access the document, however unlikely that possibility may be. There was no evidence whatsoever in this case that a searchable database containing

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[2] The Federal Circuit Court of Appeals has adopted decisions by the C.C.P.A. as binding precedent. *In re Graves*, 69 F.3d 1147, 1150 n.3 (Fed. Cir. 1995).

the information existed, or that there was any published reference to the material of any kind. It was merely there to be found, if at all, by happenstance. As Judge Newman stated, "the present case applies a standard unsupported by any precedent. We should maintain a consistent and reliable standard of what constitutes a 'printed publication.'" (20a.)

This case thus presents the question of whether it is ever proper for the Courts to declare statutory language obsolete and to substitute judicial refashioning of a statute by reinterpretation in place of Congressional policymaking. Even if this Court concludes that judicial amendment of § 102 was proper, this case presents the question of whether the standard developed and applied by the Federal Circuit has moved so far away from the plain meaning of the statute as to have impermissibly departed from the intent of Congress.

B. The Role of the Courts is to Interpret and Apply Statutes in Accordance with their Plain Meaning at the Time the Statute was Enacted.

Recent Supreme Court case law reinforces the long-standing rule that the role of the Courts in statutory interpretation is to first look to the plain meaning of the language used by Congress. It is well established that "when the statute's language is plain, the sole function of the courts—at least where the disposition required by the text is not absurd—is to enforce it according to its terms." *Lamie v. United States Trustee*, 540 U.S. 526, 534 (2004).

Further, this Court has held that statutory terms should be interpreted according to their meaning at the time the statute was enacted, not at the time of interpretation. In *BedRoc Limited, LLC v. United States*, 541 U.S. 176 (2004), this Court held that sand and gravel were not "valuable minerals" for purposes of the Pittman Underground Water Act of 1919, as the "preeminent canon of statutory

interpretation require[d] [it] to 'presume that [the] legislature says in a statute what it means and means in a statute what it says there.'" *Id.* at 183 (quoting *Connecticut Nat'l Bank v. Germain*, 503 U.S. 249, 253-54 (1992)). In *BedRoc Limited*, the Court held that the proper inquiry was to look only to "whether the sand and gravel found in Nevada were commonly regarded as 'valuable minerals' in 1919." *Id.* at 184. Thus, even if sand and gravel had a bigger market in 2004 than in 1919, this fact would be irrelevant to the statutory interpretation question. *Id.* at 184-85. Similarly, in *Amoco Production Co. v. Southern Ute Indian Tribe*, 526 U.S. 865 (1999), this Court held that the term "coal" in the Coal Lands Acts of 1909 and 1910 did not include the coalbed methane gas (CBM) contained therein. The question was not "whether, given what scientists know today, it makes sense to regard CBM gas as a constituent of coal, but whether Congress so regarded it in 1909 and 1910." *Id.* at 873.

Under *BedRoc Limited* and *Amoco Products*, statutory meaning is ascertained from the ordinary, plain meaning of the statute at the time of its enactment. These cases stand for the proposition that a term's meaning is fixed, and cannot be altered by the Courts over time, by rewriting statutes for Congress to meet judicially-perceived new circumstances or technology. Quite simply, rewriting legislation to meet the times is Congress's job under Article I, Section 1 of the U.S. Constitution: "All legislative power shall be vested in a Congress of the United States, which shall consist of a Senate and House of Representatives." (Emphasis supplied.)

Under the standard established by this Court, an assertion such as the *Wyer* Court's that "the time has come to hold that a microfilm of a foreign patent application maintained in the foreign patent office...is a 'printed publication'" is simply wrong. 655 F.2d at 227 (C.C.P.A. 1981). As in *Amoco Products*, even though modern

technology may suggest that microfilm or other types of information should be included under the statute as invalidating prior art, this does not suggest that courts may make such choices for Congress. Rather, if the meaning of the language is plain – as it is here – under *BedRoc Limited* and *Amoco Products*, the Court must continue to apply that plain meaning in all future situations. If sand suddenly becomes a valuable commodity, the Pittman Act will still not regulate its use. *BedRoc Limited*, 541 U.S. at 184-85. If microfilm or other information have become more accessible over time, this does not mean these items have become "printed publications" under § 102(a) or (b). The Federal Circuit's decision in this matter and its precedents, including *Wyer*, have impermissibly redrafted §§ 102 (a) & (b), substituting their judgments and policy choices for those of Congress and need to be corrected.

C. Congress Intentionally Chose the "Printed Publication" Language of §§ 102 (a) & (b) and Limited Foreign Invalidating Prior Art only to "Printed Publications."

Congress wrote the patent statute to prohibit a patent for any invention "patented or described in a printed publication in this or a foreign country" with the intention that only novel inventions would meet the strict standards necessary to deserve the grant of a patent. The public policy behind the prior art rules of § 102 in general, is that in consideration for the patent grant, "something must be given to the public which it did not have before.... If the public is already possessed of that 'something,' or if it is accessible to the public, there is a failure of consideration and no patent may be granted." *In re Tenney*, 254 F.2d 619, 624 (C.C.P.A. 1958). However, it is apparent from the structure of §§ 102 (a) & (b) that Congress intentionally and selectively distinguished between types of prior art within the U.S.

which would invalidate, and invalidating prior art from a foreign country. Under § 102 (a), prior art that precedes the invention by the patentee by more than one year will invalidate if the invalidating "invention was known or used by others in this country." Likewise, in § 102 (b), the fact that the invention was "in public use or on sale in this country" more than one year before the filing of the patentees application will invalidate. But under neither subsection do knowledge, use or sale in a foreign country invalidate. Under both §§ 102 (a) & (b) the only foreign prior art that will invalidate is a "printed publication."[3] See *In re Tenney*, 254 F.2d at 626.

Based on the structure and language of the statute as enacted by Congress, it is plain that one policymaking decision Congress made was that to invalidate an issued U.S. Patent, foreign prior art must be printed and published so that:

> ... the subject matter would be made known *to the American public.* Knowledge and use in the United States would probably (or so Congress must have reasoned) come to the attention of the American people whereas the same probability would not be present with respect to such knowledge and use abroad. By the same token, in the case of 'printed' publications, Congress no doubt reasoned that one would not go to the trouble of printing a given description of a thing unless it was desired to print a number of copies of it.

In re Tenney, 254 F.2d at 626 (emphasis supplied).

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[3] Or an issued patent. But whether the '119 Patent itself invalidates the Bruckelmyer patents was not at issue in the Motions before the District Court which have resulted in this appeal.

Congress also made the express policy choice to narrow the type of document that would operate to invalidate a patent. The "printed publication" wording was expressly chosen to replace language in earlier statutes that provided that any "public work" could invalidate. *Id.* As *Tenney* noted, the present statute "does not contemplate any 'public work' as being a bar, but some special public work, namely, a printed publication." *Id.* at 625 (quoting *Gulliksen v. Halberg*, 75 U.S.P.Q. 252, 254-255 (Pat. & Tr. Office Bd.App. 1937)). Congress's concern in requiring that a foreign document be "printed" was to insure a likelihood that the document would be disseminated in such a way as to come to the attention of the American public. Printing was chosen because "one would not go to the trouble of printing a given description of a thing unless it was desired to print a number of copies of it." *Id.* at 626. This would "insure general distribution or publication." *Id.* (quoting *Gulliksen v. Halberg*, 75 U.S.P.Q. at 255). In addition, Congress required that a document not only needed to be printed, but published as well:

> Printing alone, of course, would be insufficient to reasonably assure that the public would have access to the work, for the possibility always exists that the printed matter may be suppressed and might never reach the public. Then, too, there are time lapses between the printing and the publishing of a given work, and the public is not to be charged with knowledge of a subject until such time as it is available to it. For this reason, it is required that the description not only be printed but be published as well.

In re Tenney, 254 F.2d at 626.

In sum, Congress made deliberate policy choices to narrow the field of foreign prior art which would invalidate

an issued U.S. Patent. The foreign art could not merely be a piece of paper in a foreign file somewhere that might be publicly accessible in that country, but not published in such a way as to contribute to public knowledge in the U.S. Congress determined that the art needed to be a printed publication, because printing, consisting of copying by sheets as opposed to copying letter by letter, could be expected to be done where the intention was to distribute multiple copies. *Id.* This in turn would create the probability that the document would reach the U.S. public and contribute to knowledge in the U.S.

The *Tenney* Court noted that the statute, as drafted by Congress, had flaws:

> It is no doubt true that the present law is anomalous, as evidenced by our conclusion that the microfilm is not 'printed.' A foreign patent file, laid open for public inspection, is not a printed publication, because typewritten, while a printed publication, available to the public only in a Southern Rhodesian library, would be. The former is obviously more likely to reach the eyes of the American public than the latter. It is obvious, however, that unless we are to rewrite 35 U.S.C. 102(b) for Congress, this must be the result reached. Our job is to interpret the law, not to make it.

Id. at 627 (emphasis supplied).

D. The Federal Circuit, Relying on the Precedent of the Court of Customs and Patent Appeals Before It, Has Impermissibly Rewritten the Printed Publication Rule for Congress.

The *Tenney* Court was correct. It was then and continues to be the job of the Courts to interpret the law, not to make it by judicial fiat or recrafting of Congressional

statutes by interpretation. Unfortunately, that is precisely what has occurred in the present case, where two hand drawings and one typewritten piece of paper, none of which have ever been printed or published anywhere or in any way, and which can only be examined by traveling in person to the CIPO in Hull, Quebec, have been deemed "printed publications."

In *Tenney* the Court held that a microfilmed copy of the typewritten specification of a German patent application did not invalidate a pending patent application because microfilm was not printed: "While microfilming furnishes a means of multiplying copies, there is no probability, from a mere showing that a microfilm copy of a disclosure has been produced, that the disclosure has achieved wide circulation and that, therefore, the public has knowledge of it." 254 F.2d at 627. In *Wyer*, the Court came to just the opposite conclusion, holding that a microfilm copy of an Australian patent application was a printed publication where an abstract of the application had been published in the patent office bulletin and diazo copies had been distributed to five Australian branch patent offices. 655 F.2d at 227. In so doing the *Wyer* Court adopted a new standard for determining whether a document is a printed publication, based in part on prior decisions in other Federal courts, which had been critical of Congress's printed publication rule.[4] It said that "printed publication" should be approached as a unitary concept, the traditional dichotomy between "printing" and "publication" being no longer valid. *Id.* at 226. It concluded that the standard should be a fact-intensive one to be decided by the courts on a case-by-case basis, the analysis turning on whether the document is "publicly accessible":

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[4] *Philips Elec. & Pharm. Indus. Corp. v. Thermal & Elec. Indus., Inc.*, 450 F.2d 1164 (3d Cir. 1971) and *I.C.E. Corp. v. Armco Steel Corp.*, 250 F.Supp. 738 (S.D.N.Y.1966).

> In other words, such a reference is a "printed publication" and a bar to patentability *** upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation.

655 F.2d at 226 (citing *I.C.E. Corp.*, 250 F.Supp. at 743).

Wyer did what the same Court had said 23 years earlier it would not do, it rewrote the "printed publication" statutes for Congress. In so doing, it did not merely ignore or misinterpret the plain meaning of the statutory language, it expressly invalidated it. It substituted in its place a judicial doctrine, a fact-based case-by-case examination of whether a particular document or form of information, located in a foreign country, should be considered sufficiently publicly accessible to be considered invalidating prior art. All based on an evolving legal standard.

The Federal Circuit has made the error not only of embracing *Wyer* as precedent, but of watering the printed publication rule down even further than the *Wyer* Court was willing to go. At least in *Wyer* an abstract of the Australian patent application at issue had been published by the Australian Patent Office, so that a published summary existed as to what the patent application contained. In the present case there has been no publication of the invalidating material from Young's initial patent application at all. Young's application was never published, it was merely "laid open" in Canada once Young's patent issued. Young's patent contained no reference to the invalidating material, because Young cancelled the material and withdrew it from further examination. There is not even any evidence as to

what a person reasonably skilled in the art or a reasonable patent searcher would have to do to locate the material, other than be lucky.[5]

With all respect to the Federal Circuit, their decision in the present case dilutes the statutory requirement as written by Congress to the point where it is merely sufficient that material exists in some public file somewhere. It stands Congressional patent policy on its head, because it permits someone outside the U.S. who has given virtually nothing to the U.S. public to preclude a U.S. inventor who does make such a contribution from obtaining a valid patent.

It is no doubt tempting for the judiciary to tinker with Congressional legislation, especially when new circumstances or technologies arise which were not contemplated when the legislation was written, or when the legislation appears imperfect. But the appropriate remedy is not to "fix" the statute for Congress, it is to call Congress's attention to the issues and to leave it to Congress to exercise its legislative power. Congress made clear and express policy choices in writing §§ 102 (a) & (b) which are plain from the language and structure of the statutes themselves. For example, Congress plainly believed that to invalidate a U.S. Patent, foreign art should be distributed in a way that contributes to the knowledge of the American public. Whether this choice is too protective of U.S. interests or not protective enough is not for the Courts to decide, it is for Congress. It is a policy underpinning which has not made an

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[5] As noted, the record is void of any evidence as to how a person reasonably skilled or interested in the art would have located the invalidating material. In this case, the pro se petitioner took the highly unusual step of cancelling virtually the entire initial application, including the invalidating material, and replacing it. No evidence exists whether a reasonable patent searcher, looking at the '119 Patent, would ever have expected to locate the cancelled material by reviewing the file wrapper. We think not.

appearance in the language of the many written opinions on this issue since *Tenney* discussed it in 1958.

This Court should take this appeal to correct the recrafting of these statutes which has and continues to occur, and leave it to Congress to decide if new methods of communication require new language and policy choices, and what those choices should be.

E. The Federal Circuit's Interpretation of §§ 102 (a) & (b) Departs So Far from their Plain Meaning and Legislative Intent as to Require the Intervention of This Court to Establish a Consistent Rule.

Even if this Court does not agree that the chain of decisions from *Wyer* to the present case represent judicial recrafting of §§ 102 (a) & (b), the Court should take the present appeal to establish a consistent "printed publication" rule. It is apparent from the result, as the present case reflects, the *Wyer* case-by-case analysis has led the Courts down a slippery slope ever further away from the Congressional intent behind the statutes. As Judge Newman wrote in her dissent from the denial of Bruckelmyer's Petition for Rehearing and Rehearing En Banc, " The present case applies a standard unsupported by any precedent. We should maintain a consistent and reliable standard of what constitutes a "printed publication." (20a.)

The standard established in *Wyer* was whether the foreign art was "publicly accessible," which *Wyer* went on to define as meaning that there must be a showing that the document had been disseminated in such a way that persons reasonably skilled in the art, exercising reasonable diligence, could locate and comprehend it. 655 F.2d at 226. The development of the case law, however, has included no standards for determining whether a person reasonably skilled in the art could locate the material. In fact, in the

present case there was a complete absence of any evidence as to how or whether a person "interested and ordinarily skilled in the subject matter or art" might go about locating it, or whether they could locate it at all without the intervention of fate, luck and "sheer happenstance." *See Id.*, 12a and 19a.

In reality, what appears to have happened to the standard established in *Wyer*, is that the criterion has become mere "public accessibility." Is there a document in a public file somewhere that invalidates the invention which a member of the public (whether a member of the U.S. public or not) can possibly access? Is it sufficient for an infringer to search the world and, by luck, come up with invalidating art, or is it necessary for the infringer to show that the art was available in a way that it could be said to contribute to U.S. knowledge on the subject? These questions were raised during oral argument before the Federal Circuit panel, and the panel majority has chosen the broadest possible standard, simply, is it possible to access the document.

Prior to the present case, although the Federal Circuit had broadened the standard beyond a traditional "printed publication," it had nevertheless required meaningful distribution, indexing, or public display of the material to the public interested in the art. In *In re Cronyn*, 890 F.2d 1158 (Fed.Cir. 1989) the Court declined to find three student theses the titles of which were merely listed on 3 out of 450 cards filed alphabetically by author in a shoebox in departmental library at a university to be printed publications. Applying the *Wyer* standard, the Court said that indexing, cataloging, and shelving were required for such a document to be "publicly accessible" and that under that standard, the theses were not. See also, *In re Hall*, 781 F.2d 897 (Fed. Cir. 1986) (single copy of theses which was shown by the evidence to have been properly shelved and indexed was invalidating).

In *In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004) the Court declined to require distribution and indexing where

the patentee displayed a slide show disclosing the invention for several days, at a conference attended by persons skilled in the art. The Court stated that, "the key inquiry is whether or not a reference has been made 'publicly accessible'," and found that the slide show was a printed publication. *See, also, Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104 (Fed. Cir. 1985) (paper disclosing the invention was presented at a conference of persons reasonably skilled in the art, and at least six copies were distributed).

In these prior cases, although the Federal Circuit cast an ever widening net with the "printed publication" rule, it at least required either actual distribution or display of the invalidating art to persons reasonably skilled in the art, or its equivalent in the form of indexing, cataloging, or as in *Wyer*, the publication of an abstract, which could be used by persons reasonable skilled and interested in the art to locate the material.

In its precedential decision in the present case, however, there are none of these indicia of "sufficient public accessibility" that would lead to the expectation that persons skilled in the art would locate the material. The panel majority of the Federal Circuit has instead embraced a rule of pure "public accessibility" – it is possible that someone somewhere might locate the document. This was certainly not the standard intended by Congress when it wrote the statute, in fact, it completely ignores Congress's intention that the art must be accessible to the American public. It is also not the standard established in *Wyer*, which requires an evidentiary showing of sufficient accessibility that persons skilled in the art, with reasonable diligence, could locate the document. And finally, it does not comport with the Congressional intent of 35 U.S.C. § 282 and cases interpreting that statute which establish a presumption of validity for issued patents, and require a showing of invalidity by clear and convincing evidence. *Enzo Biochem*,

424 F.2d at 1281. In this case, there was no evidentiary showing by the defendants at all.

The opinion of the panel majority of the Federal Circuit leaves the law concerning the "printed publication" unsettled and in dispute. It appears to establish a "mere public accessibility" rule for foreign invalidating materials, and departs markedly from the intent of Congress in writing the statute. Moreover, it leaves the Federal Circuit itself divided on what the rule should be, as demonstrated by the strongly worded dissents of Judges Linn and Newman. This Court should accept this appeal to establish consistent rules for the interpretation and application of the "printed publication" rule.

CONCLUSION

It is respectfully suggested that the Federal Circuit decisions in the case at hand and its precedents have impermissibly rewritten the statute for Congress. In so doing, the Courts have necessarily made policy judgments, which are matters for Congress to decide, as to what foreign documents should constitute invalidating foreign art. The Federal Circuit's decision appears to hold that a document in Canada, which can be found and reviewed only by going to Canada will invalidate. The decision appears to change Congress's intent that foreign art must make a contribution to the knowledge of the U.S. public. The Courts have converted the "printed publication" rule to a test of mere "public accessibility" – is it possible for the public to access a document? They have lost sight of Congress's intent that a foreign document must have been printed with the intention of dissemination, so as to be likely to contribute to the knowledge of the U.S. public. In short, today's test is essentially whether an accused infringer can find a scrap of paper hidden in a public file anywhere in the world, not whether the document would likely have made a contribution to the knowledge of persons in the U.S., and certainly not

whether the document is a "printed publication" within the plain meaning of the statute.

The petition for a writ of certiorari should be granted.

Dated: September, 2006

Respectfully submitted,

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APPENDIX

APPENDIX

Opinion of the U.S. Court of Appeals
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Federal Circuit Denial of Panel Rehearing
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Opinion of U.S. District Court for the
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Opinion of U.S. District Court for the
District of Minnesota (May 13, 2005)..... .....30a

United States Court of Appeals, Federal Circuit

Mark BRUCKELMYER, Plaintiff-Appellant,

v.

GROUND HEATERS, INC., Defendant,

and T.H.E. Machine Company, Defendant-Appellee.

No. 05-1412.

April 20, 2006.

Background: Patentee appealed from decision of the United States District Court for the District of Minnesota, Donovan W. Frank, J., 2005 WL 1155938, granting summary judgment of invalidity of two patents in favor of competitors.

Holding: The Court of Appeals, Lourie, Circuit Judge held that Canadian patent application, including two figures associated with it, was "publicly accessible," and thus was a "printed publication" under statute establishing conditions for patentability.

Affirmed.

Linn, Circuit Judge, filed dissenting opinion.

***1375** John B. Lunseth II, Briggs and Morgan, P.A., of Minneapolis, Minnesota, argued for plaintiff-appellant. With him on the brief was Michael H. Streater.

Aaron W. Davis, Patterson, Thuente, Skaar & Christensen, P.A., of Minneapolis, Minnesota, argued for defendant-appellee. With him on the brief were Randall T. Skaar and Eric H. Chadwick.

James Moskal, Warner, Norcross & Judd LLP, of Grand Rapids, Michigan, for defendant. With him on the brief was Charles E. Burpee.

Before MICHEL, Chief Judge, LOURIE and LINN, Circuit Judges.

Opinion for the court filed by Circuit Judge LOURIE. Dissenting opinion filed by Circuit Judge LINN.LOURIE, Circuit Judge.

Mark Bruckelmyer appeals from the decision of the United States District Court for the District of Minnesota granting summary judgment of invalidity of U.S. Patents 5,567,085 and 5,820,301 (the "patents in suit") in favor of Ground Heaters, Inc. and T.H.E. Machine Company (collectively "Ground Heaters"). *Bruckelmyer v. Ground Heaters, Inc.*, No. 02-CV-1761, 2005 WL 1155938 (D.Minn. May 13, 2005) ("*Final Decision* "). Prior to the district court's entry of judgment, Bruckelmyer stipulated that if the Canadian patent application that issued as Canadian Patent 1,158,119 ("the '119 application") were a "printed publication" under 35 U.S.C. § 102(b), it would render the patents in suit invalid on the ground of obviousness. *Id.*, slip op. at 6. Because the court correctly determined that the '119 application, including figures 3 and 4 contained therein, was a "printed publication," we affirm its judgment of invalidity.

BACKGROUND

On July 20, 1995, a patent application that issued as the '085 patent was filed in the U.S. Patent and Trademark Office, naming Mark Bruckelmyer as the inventor. On July 17, 1996, a continuation-in-part application that issued as the '301 ***1376** patent was filed, also naming Bruckelmyer as the inventor. Both patents disclose a method of thawing frozen ground so that a layer of concrete can be laid on top of the ground. '085 patent, col. 1, ll. 34-51; '301 patent, col. 1, ll. 34-51. According to the patents, in cold weather, the laying

of concrete is difficult because it may harden in a non-uniform manner, and concrete laid on frozen ground may later crack due to settling of the ground that thaws in warmer weather. '085 patent, col. 1, ll. 10-26; '301 patent, col. 1, ll. 10-26. In general, the patented methods place rubber hoses on the ground either around a narrow concrete footing form or within a large concrete form. '085 patent, col. 2, l. 25-col. 3, l. 58; '301 patent, col. 2, l. 25-col. 4, l. 15. A liquid that is heated, such as water or antifreeze, is then circulated through the hoses, which thaws the frozen ground and prevents the concrete from hardening too quickly. *Id.*

On May 7, 1982, over thirteen years before Bruckelmyer filed the applications that issued as the '085 and '301 patents, Norman Young filed an application that issued as Canadian Patent 1,158,119. The '119 patent subsequently issued on December 6, 1983. The '119 patent discloses a portable heating system that places flexible hoses "in close proximity to objects of various shapes and configurations which would otherwise be difficult to heat." '119 patent, abstract. Like the patents in suit, the '119 patent discloses a method of heating structures by having preheated liquid flow through flexible hoses. Also, similar to the patents in suit, the '119 patent states that the "primary object of this invention is to provide an improved method of applying heat to fresh concrete which has been placed in pre-constructed formwork during extreme cold weather." *Id.* To illustrate an application of the invention, the '119 patent provides drawings of the claimed heating system being used to heat a beam. The patent further notes that the "system is suitable for applying heat to other subjects and is not necessarily confined to use in relation to concrete placement. Other typical uses are: ... thawing frozen ground." *Id.*, at p. 2. Relevant to this appeal, the '119 patent omits certain drawings that were contained in the application as filed, *viz.*, two drawings illustrating the use of the disclosed heating system to thaw frozen ground ("figures 3 and 4"). Figures 3

and 4 are not in the issued patent because they were cancelled during prosecution. Nonetheless, they still remain in the '119 patent's file wrapper.

Moving forward to July 15, 2002, Bruckelmyer filed a complaint against Ground Heaters, one of his former licensees, for infringement of the patents in suit. In its responsive pleading, Ground Heaters filed a counterclaim asserting that the patents in suit were invalid.[1] On December 19, 2002, Ground Heaters filed a motion for summary judgment of invalidity based on, *inter alia,* figures 3 and 4 of the '119 application. The court denied Ground Heaters' motion for summary judgment of invalidity upon finding a genuine issue of material fact regarding whether a person of ordinary skill in the art would have been enabled by figures 3 and 4 to practice the technology claimed by the patents in suit without undue experimentation. *Bruckelmyer v. Ground Heaters, Inc.*, No. 02-CV-1761, slip op. at 8, 2003 WL 21402870 (D. Minn. June 16, 2003) ("*Initial Decision* ").

In reaching its decision to deny summary judgment, the court determined that the '119 application was a "printed publication"***1377** under § 102(b). *Id.* The court noted that the '119 patent and its application were available for public inspection at the Canadian Patent Office in Hull, Quebec, more than one year before the priority date of the patents in suit. *Id.* The court also determined, albeit in a conclusory manner, that "the contents of the file wrapper [were] sufficiently accessible to the relevant and interested public as to constitute a printed publication for purposes of § 102(b)." *Id.*

In view of the court's determination that figures 3 and 4 of the '119 application constituted § 102(b) prior art, Bruckelmyer filed a stipulation in the court conceding that

[1] It is unclear from the record whether Ground Heaters claimed that its products did not infringe the patents in suit. The answer to that question, however, is not necessary for us to decide this appeal.

those figures rendered the claims of the patents in suit invalid. *Final Decision*, slip op. at 6. In doing so, Bruckelmyer removed from dispute any question of fact as to whether those figures were enabling to a person of ordinary skill in the pertinent art. Ground Heaters filed a renewed motion for summary judgment of invalidity, which the court granted on May 13, 2005. *Id.* Bruckelmyer timely appealed, and we have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).[2]

DISCUSSION

We review a district court's grant of summary judgment *de novo*, reapplying the same standard used by the district court. *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1315 (Fed.Cir.1998). Summary judgment is appropriate if there is no genuine issue as to any material fact and the moving party is entitled to a judgment as a matter of law. Fed.R.Civ.P. 56(c). "Whether an anticipatory document qualifies as a 'printed publication' under § 102 is a legal conclusion based on underlying factual determinations." *Cooper Cameron Corp. v. Kvaerner Oilfield Prods.*, 291 F.3d 1317, 1321 (Fed.Cir.2002). Where there is no disputed issue of material fact, however, the question whether a particular reference is a "printed publication" is one of law, which we review *de novo*. *In re Cronyn*, 890 F.2d 1158, 1159 (Fed.Cir.1989).

The single legal issue in this appeal is whether figures 3 and 4 of the '119 application were "printed publications" under 35 U.S.C. § 102(b). Bruckelmyer argues that the district court erred in concluding that they were. For a reference to be a "printed publication,"

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[2] Ground Heaters, Inc. and T.H.E. Machine Company were both appellees when this appeal was originally filed. Since then, Bruckelmyer and Ground Heaters have settled and Ground Heaters is no longer part of this appeal. The appeal between Bruckelmyer and T.H.E. Machine Company, however, remains pending.

Bruckelmyer asserts, it must be "publicly accessible," as that term has been used in our prior decisions. Bruckelmyer contends that a patent application located in a foreign patent office, *e.g.*, the '119 application, is not "publicly accessible" just because it is laid open for inspection by the general public during the relevant prior art time frame. Relying on our decisions in *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed.Cir.2004), and *In re Cronyn*, 890 F.2d at 1161, Bruckelmyer asserts that for a prior art reference to be considered "publicly accessible," it must either (1) be published to those interested in the art for a sufficient amount of time to allow them to "captur[e], process[ ] and retain[ ] the information conveyed by the reference, or (2) those interested must be able to locate the material in a meaningful way."

Bruckelmyer asserts that the '119 application did not meet either criterion, and thus it was not "publicly accessible." According to Bruckelmyer, there was no evidence in the record indicating that the contents of the file wrapper were disseminated, as the '119 file wrapper was only ***1378** located in the Canadian Patent Office in Hull, Quebec, and there were no copies known to have been made and sent elsewhere during the prior art period. Moreover, Bruckelmyer contends that a person of ordinary skill in the art interested in the subject matter of the patents in suit, *viz.*, a method for thawing frozen ground by using flexible hoses and heated liquid, would not have been able to locate figures 3 and 4 because the Canadian Patent Office did not index or catalogue the '119 application. Nor was there a printed abstract of the '119 application that was classified and published to allow one skilled in the art to locate figures 3 and 4, according to Bruckelmyer. Finally, Bruckelmyer argues that the '119 patent itself would not have guided a person of ordinary skill in the art to locate figures 3 and 4 because the figures were "removed" from the application during prosecution.

Ground Heaters responds by arguing that, although the '119 application was not formally indexed, a person of ordinary skill in the art would have been able to locate the figures contained in the '119 application through the published '119 patent. According to Ground Heaters, the following statement contained in the '119 patent would have led one skilled in the art to the '119 application, and hence to figures 3 and 4: "[the claimed system] is suitable for applying heat to other objects and is not necessarily confined to use in relation to concrete placement. Other typical uses are: ... thawing frozen ground." Moreover, Ground Heaters notes that the '119 patent was indexed and catalogued according to its subject matter, and the application was in the file of the patent in the patent office; *ipso facto,* the application was also, as a practical matter, indexed and catalogued.

[1][2][3][4] We agree with the district court that the '119 application and the figures 3 and 4 associated with it, was "publicly accessible," and thus that it was a "printed publication" under 35 U.S.C. § 102(b). The "printed publication" provision of § 102(b) "was designed to prevent withdrawal by an inventor ... of that which was already in the possession of the public." *In re Wyer,* 655 F.2d 221, 226 (CCPA 1981). Whether a given reference is a "printed publication" depends on whether it was "publicly accessible" during the prior period. *Id.* A given reference is "publicly accessible"

upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation.

Id. (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F.Supp. 738, 743 (S.D.N.Y.1966)). Although Ground Heaters does not assert that the '119 application with figures 3 and 4 was actually disseminated during the relevant prior art time frame, Bruckelmyer has conceded that figures 3 and 4 of the application were in the patent file and were enabling. Thus, the only question that remains for us to answer is whether a person of ordinary skill in the art interested in the subject matter of the patents in suit and exercising reasonable diligence would have been able to locate the '119 application. If the answer to that question is "yes," then the '119 application, including figures 3 and 4, was "publicly accessible" and the patents in suit are invalid.

Controlling in our determination whether the '119 application was "publicly accessible" is our predecessor court's decision in *In re Wyer*. In that case, an Australian patent application was laid open for public ***1379** inspection and an abstract of the application was published by the Australian Patent Office more than two years before the filing date of the corresponding U.S. patent application at issue in that case. *Id.* at 222. The existence of a published abstract that would have allowed one skilled in the art exercising reasonable diligence to locate the foreign patent application and the fact that the application was classified and indexed in the patent office, were central to the *Wyer* court's conclusion that the application was "publicly accessible." The court noted, "[g]iven that there is no genuine issue as to whether the application was properly classified, indexed, or abstracted, we are convinced that the contents of the application were sufficiently accessible to the public and to persons skilled in the pertinent art to qualify as a 'printed publication.' " *Id.* at 226.

In this case, the published '119 patent is even more of a roadmap to the application file than the abstract was in *Wyer*. As Ground Heaters observed, the '119 patent states

that a possible use of the claimed invention is to thaw frozen ground by circulating heated liquid through flexible hoses-the same use contemplated by the methods claimed in the patents in suit. Given such a pertinent disclosure, we conclude that no reasonable trier of fact could find that a person of ordinary skill in the art interested in the subject matter of the patents in suit and exercising reasonable diligence could not locate the '119 application, including figures 3 and 4 contained therein.[3] Indeed, it would be inconsistent to determine that one skilled in the art could have located a foreign patent application based on information in a published abstract, as our predecessor court found in *In re Wyer,* but not here, where there was an issued patent. After all, an issued patent is presumably more informative of the content of its application file than a mere abstract of the patent application. Moreover, there is no genuine dispute that the '119 patent was classified and indexed, as the abstract was in *Wyer,* further providing the roadmap that would have allowed one skilled in the art to locate the '119 application. Because no reasonable trier of fact could have found that the '119 patent did not provide sufficient information to allow a person of ordinary skill in the art to locate the '119 application, including the figures contained therein, we agree with the district court and conclude that that application was "publicly accessible," and hence an invalidating § 102(b) prior art reference.

Bruckelmyer's reliance on *In re Cronyn* to argue that the '119 application was not "publicly accessible" is misplaced as that case is factually distinguishable. *In re Cronyn,* we determined that the student theses at issue were not meaningfully catalogued or indexed, and thus they were not "publicly accessible." 890 F.2d at 1161. The

[3] We do not express an opinion regarding the unusual situation where the prior art reference at issue is contained in a foreign file wrapper, but otherwise bears little relation to the subject matter of the issued and published patent.

significance of whether these theses were meaningfully catalogued or indexed was whether one skilled in the art could locate them. In this case, however, it does not matter whether the '119 application was catalogued or indexed "in a meaningful way" because the '119 patent was indexed and could serve as a "research aid." *Id.* And, as we explained above, no reasonable trier of fact could find that the '119 patent did not contain sufficient disclosure to serve that purpose.

Equally unpersuasive is Bruckelmyer's argument that figures 3 and 4 were "removed" from the application during prosecution, and thus a person of skill in the art would not have looked past the '119 patent in searching for the subject matter of the ***1380** patents in suit. As a matter of undisputed fact, the '119 patentee did not physically remove figures 3 and 4 from the file wrapper, but merely cancelled the subject matter figures from the patent during prosecution. The figures were thus still in the file, although they did not appear in the issued patent. The declaration from Bruckelmyer's Canadian patent law practitioner explains that when subject matter is cancelled during prosecution a replacement page may be put in front of the page containing the cancelled matter, but the page containing the cancelled original matter still remains in the file wrapper. Moreover, for the reasons that we articulated above, it does not matter that figures 3 and 4 do not appear in the '119 patent because no reasonable trier of fact could find that there was not sufficient disclosure in the patent to allow one skilled in the art to locate the figures contained in the application.

CONCLUSION

For the aforementioned reasons, the district court's decision granting summary judgment of invalidity of the patents in suit in favor of Ground Heaters is affirmed.

AFFIRMED

LINN, Circuit Judge, dissenting.

I respectfully dissent from the majority's decision to affirm the district court's grant of summary judgment of invalidity of the patents in suit. Because the district court erred in holding that the patent application that issued as Canadian Patent No. 1,158,119 ("the '119 application") was a "printed publication" under 35 U.S.C. § 102(b), I would vacate the district court's summary judgment of invalidity and remand for further proceedings.

The majority distinguishes *In re Cronyn*, 890 F.2d 1158 (Fed.Cir.1989) by concluding that the issued '119 patent serves as an index to the '119 application. *Ante* at 1379. ("[I]t does not matter whether the '119 application was catalogued or indexed 'in a meaningful way' because the [issued] '119 patent was indexed...."). The majority elaborates that the issued '119 patent is even more of a roadmap to the application file than an abstract, inferring that the issued patent can take the place of a classified and indexed abstract, and, relying on our precedent in *In re Wyer*, 655 F.2d 221 (C.C.P.A.1981), contends that the indexed patent makes the '119 application "publicly accessible." *Ante* at 1379.

In my opinion, it is not entirely sound to view the issued '119 patent as a roadmap to the underlying file history. An abstract, which is similar in many respects to a library index card, is a brief statement of the contents of something else; *i.e.*, the more extensive text to which it refers. It is intended to serve as a tool to steer researchers to the content of a larger and more comprehensive work. The abstract contained in an issued patent, for example, is a summary of the technical information contained in the specification. On the other hand, the printed text of an issued patent-including the abstract, written description, and claims-is not necessarily looked to as a summary or index of the underlying file history. While it is commonplace for parties

to examine patent file histories for guidance on matters of claim interpretation, surrender, estoppel, disclaimer, or disavowal, researchers normally expect the text of printed patents to correspond to and be coextensive with the applications from which they have been issued. In that sense, the text of an issued patent does not generally serve to guide researchers to the file history for a more expansive disclosure of the described invention, and it certainly does not lead researchers to the file history for disclosure of subject matter not described in the issued text.

***1381** Moreover, even if an issued patent may be considered a form of index to the underlying file history, there is nothing in the text of the issued '119 patent to suggest that a disclosure of structure for implementing the "thawing frozen ground" use will be found in the underlying '119 application. The fact that an additional drawing, disclosing additional structure, is present in the application file is a matter of sheer happenstance nowhere indicated in the issued patent. For this reason, it is my view that, as in *Cronyn,* the anticipatory drawings at issue in this case are "not accessible to the public because they have not been cataloged or indexed in a meaningful way." *See* Cronyn, 890 F.2d at 1161.

Public accessibility has been the touchstone by which a prior art reference satisfies the purposes of 35 U.S.C. § 102(b). *See In re Wyer,* 655 F.2d at 226 (stating that the entire purpose of the "printed publication" bar was to "prevent withdrawal" of disclosures "already in the possession of the public" by the issuance of a patent). In *Klopfenstein,* this court discussed that the requirement of public accessibility can be satisfied under a variety of conditions, including when there has been a meaningful distribution, indexing, or display of the material to the public interested in the art. *See generally In re Klopfenstein,* 380 F.3d 1345 (Fed.Cir.2004). In *Klopfenstein,* we held that a

reference was made sufficiently publicly accessible because, despite that it was not indexed and copies were not distributed to the public, it was prominently displayed for several days to a wide variety of interested viewers who were free to take notes or photographs, and copying would have been a simple undertaking. *Id.* at 1350. In this case, in addition to not being meaningfully indexed, as discussed above, no copies were known to have been made or distributed during the critical period, and the '119 application was available for viewing only at the Canadian Patent Office in Hull, Quebec.

For the foregoing reasons, it is my view that the limited reference in the issued '119 patent to "thawing frozen ground" did not put the public in possession of the canceled drawings in the '119 application. Because the district court erroneously determined that the '119 application, including the canceled drawings, was a "printed publication," I would vacate the district court's grant of summary judgment and remand.

United States Court of Appeals, Federal Circuit.

Mark BRUCKELMYER, Plaintiff-Appellant,

v.

GROUND HEATERS, INC., Defendant,

And T.H.E. Machine Company, Defendant-Appellee.

No. 2005-1412.

June 28, 2006.

Appealed from: United States District Court for the District of Minnesota. Judge Donovan W. Frank.
ON PETITION FOR PANEL REHEARING AND REHEARING EN BANC

John B. Lunseth II, Briggs and Morgan, P.A., of Minneapolis, Minnesota, filed a combined petition for panel rehearing and rehearing en banc for plaintiff-appellant. With him on the petition was Michael H. Streater.

Aaron W. Davis, Patterson, Thuente, Skaar & Christensen, P.A., of Minneapolis, Minnesota, filed a response to the petition for defendant-appellee. With him on the response were Randall T. Skaar and Eric H. Chadwick.

James Moskal, Warner, Norcross & Judd LLP, of Grand Rapids, Michigan, for defendant. Of counsel was Charles E. Burpee.

Before MICHEL, Chief Judge, NEWMAN, MAYER, LOURIE, RADER, SCHALL, BRYSON, GAJARSA, LINN, DYK, and PROST, Circuit Judges.

NEWMAN, Circuit Judge, dissents in a separate opinion, in which LINN, Circuit Judge, joins.

ORDER

A combined petition for panel rehearing and rehearing en banc was filed by the Appellant, and a response thereto was invited by the court and filed by the Appellee. The petition for rehearing was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc and response were referred to the circuit judges who are authorized to request a poll whether to rehear the appeal en banc. A poll was requested, taken, and failed.

Upon consideration thereof,

IT IS ORDERED THAT:

***1353** (1) The petition for panel rehearing is denied.

(2) The petition for rehearing en banc is denied.

(3) The mandate of the court will issue on July 5, 2006.

NEWMAN, Circuit Judge, with whom LINN, Circuit Judge, joins, dissenting from denial of the petition for rehearing en banc.

The facts are not in dispute. The '085 and '301 patents were held invalid because of the existence of two drawings that were stored in the unpublished archive of an unrelated Canadian patent application by a different inventor. The drawings were cancelled from the Canadian application before the patent was granted, and are not referred to in the published Canadian patent. It is undisputed that these cancelled drawings are not available in any database or any library, and that no index, no catalog, no abstract suggests their existence or their content. It is not contested that the only way to obtain these drawings (although their existence was unknown) is to personally go

to the Canadian Patent Office in Hull, Quebec, and ask to examine the file wrapper (the prosecution history) of this particular patent, which is entitled "Portable Construction Heating System". This is not the method for heating frozen ground in preparation for pouring concrete, which is the subject of the patent in suit. The only lead to this particular Canadian prosecution record, we are told, is to observe that the broad recitation in the Canadian patent that "other typical uses [of the invention] are ... thawing frozen ground," and then to travel to Quebec to examine the file wrapper to see if it might contain information that was deleted from the Canadian application before issuance. This excised and unpublished and unreferenced material is not a "printed publication," no matter how generously that concept is defined. This court improperly relies on it to invalidate the United States Patents here at issue.

The patent act carefully distinguishes "prior art" in the United States and in foreign countries. The relevant portions of section 102 are:

§ 102. A person shall be entitled to a patent unless-

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States ....

Note the statute's distinction between "knowledge" or "use" in this country, on one hand, and "patented or described in a printed publication in this or a foreign country." Foreign knowledge is not prior art unless it is patented or published. Our predecessor court has explained the reason for the difference: It is to be noted that a "printed

publication" may be an effective bar to the granting of a patent if it is "in this or a foreign country." 35 U.S.C. 102(a, b). For knowledge or use of the invention to be a statutory bar, however, it must be "in this country." 35 U.S.C. 102(a). The patent act of 1836 made the same distinction. Act of July 4, 1836, c. 357, 15, 5 Stat. 123. Bearing in mind the basic nature of the patent grant, as heretofore discussed, it becomes readily evident that what Congress was concerned with, both in 1836 and 1952, was the probability that the subject matter would be made known to the American public. Knowledge and use in the United*1354 States would probably (or so Congress must have reasoned) come to the attention of the American people whereas the same probability would not be present with respect to such knowledge and use abroad. By the same token, in the case of 'printed' publications, Congress no doubt reasoned that one would not go to the trouble of printing a given description of a thing unless it was desired to print a number of copies of it.

. . . . .

Printing alone, of course, would be insufficient to reasonably assure that the public would have access to the work, for the possibility always exists that the printed matter may be suppressed and might never reach the public. Then too, there are time lapses between the printing and the publishing of a given work, and the public is not to be charged with knowledge of a subject until such time as it is available to it. For this reason, it is required that the description not only be printed but be published as well.

But though the law has in mind the probability of public knowledge of the contents of the publication, the law does not go further and require that the probability must have become an actuality. In other words, once it has been established that the item has been both printed and published, it is not necessary to further show that any given

number of people actually saw it or that any specific number of copies have been circulated. The law sets up a conclusive presumption to the effect that the public has knowledge of the publication when a single printed copy is proved to have been so published.

In re Tenney, 45 C.C.P.A. 894, 254 F.2d 619, 626-27 (1958) (footnotes and citations omitted).

The earlier cases decided by the CCPA interpreted "printed" as Congress no doubt understood the term: multiple copies that were made in order to disseminate the information. The idea was that there must be some likelihood that the information would, at least in principle, be available to interested persons in the United States. We need not consider the role in section 102 of today's searchable electronic data bases and other media, for in this case the subject matter entered no searchable library. The policy consideration for foreign prior art remains the same as when the statute was enacted-a requirement that the information be reasonably available in this country. The decisions developed the criterion that a "publication" must be "publicly accessible," as in *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981), where the court defined "publicly accessible" as meaning "disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation." In *Wyer*, upon which the panel majority relies, the information was indeed accessible, for it had been "laid open to public inspection" accompanied by routine classification and published abstract:

Appellant filed an application for an Australian patent which resulted in copies of that application being classified and laid open to public inspection at the Australian Patent Office and each of its five "sub-offices" over one year

before he filed his application in the United States. Appellant himself informs us that:

Equipment was available to the public in the Patent Office and in the sub-offices for providing an enlarged reproduction of the diazo copies on a display screen. Equipment was also available for producing enlarged paper copies for purchase by the public. ***1355** Moreover, diazo copies were also available for sale to the public upon application to the Australian Patent Office, these latter diazo copies being produced to order from the second microfilm copy ...,

Even though no fact appears in the agreed statement respecting actual viewing or dissemination of any copy of the application, there is no dispute that the records were maintained for this purpose. Given that there is also no genuine issue as to whether the application was properly classified, indexed, or abstracted, we are convinced that the contents of the application were sufficiently accessible to the public and to persons skilled in the pertinent art to qualify as a "printed publication," notwithstanding those cases holding that a foreign patent application laid open for public inspection is not a printed publication.

Id. at 226-27. In contrast, the drawings in the Canadian patent application were not available in multiple locations, could not be ordered from the Canadian patent office, were not indexed or cataloged, and their presence cannot be divined from the Canadian patent that eventually issued. As Judge Linn observes in his dissent, a person searching for prior art cannot be reasonably expected to look in the prosecution history of a foreign patent that does not disclose the invention, on the off chance that its inventor might have invented something relevant to the search, and then cancelled it from the application before grant.

In re Cronyn, 890 F.2d 1158, 1160 (Fed.Cir.1989), this court explained that "The statutory phrase 'printed

publication' has been interpreted to mean that before the critical date the reference must have been sufficiently accessible to the public interested in the art; dissemination and public accessibility are the keys to the legal determination whether a prior art reference was 'published.' " (quoting *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed.Cir.1988)). In *In re Klopfenstein*, 380 F.3d 1345 (Fed.Cir.2004) this court stated that "the appellants' argument that 'distribution and/or indexing' are the key components to a 'printed publication' inquiry fails to properly reflect what our precedent stands for," explaining that what precedent stands for is that "printed publication" means reasonably accessible through generally available media that serve to disseminate information. *Id.* at 1348. The present case applies a standard unsupported by any precedent. We should maintain a consistent and reliable standard of what constitutes a "printed publication." To this end I would re-hear this case *en banc*.

UNITED STATES DISTRICT COURT

DISTRICT OF MINNESOTA

Mark Bruckelmyer,

Plaintiff,

v.

Ground Heaters, Inc., a Michigan corporation, and T.H.E. Machine Company, a Minnesota corporation,

Defendants,

and

T.H.E. Machine Company,

Counter-claimant,

v.

Mark Bruckelmyer,

Counter-defendant.

Civil No. 02-1761 (DWF/RLE)

MEMORANDUM OPINION AND ORDER

Ronald E. Lund, Esq., David C. Forsberg, Esq., Kurt J. Niederluecke, Esq., and Lori J. Marco, Esq., Briggs & Morgan, 2200 IDS Center, 80 South Eighth Street, Minneapolis, MN 55402, counsel for Plaintiff and Counter-defendant.

Zbingniew P. Sawicki, Esq., and Peter J. Ims, Esq., Kinney & Lange, The Kinney & Lange Building, 312 Third Street South, Minneapolis, MN 55415-1002, and Douglas A. Dozeman, Esq., and James Moskal, Esq., Warner Norcross

& Judd, 111 Lyon Street Northwest, Suite 900, Grand Rapids, MI 49503-2487, counsel for Defendant Ground Heaters, Inc., a Michigan corporation.

Randall T. Skaar, Esq., Eric H. Chadwick, Esq., and Aaron W. Davis, Esq., Patterson Thuente Skaar & Christensen, 4800 IDS Center, 80 Eighth Street South, Minneapolis, MN 55402-1314, counsel for Defendant and Counter-claimant T.H.E. Machine Company, a Minnesota corporation.

Introduction

The above-entitled matter came on for hearing before the undersigned United States District Judge on February 3, 2003, pursuant to Plaintiff's Motion for Partial Summary Judgment[1] and Defendants' Joint Motion for Summary Judgment of Invalidity. For the reasons set forth below, Plaintiff's motion is denied and Defendants' Motion is denied.

Background

Plaintiff Mark Bruckelmyer holds two United States patents for a "Method of Thawing Frozen Ground," United States Patent No. 5,820,301 ("the '301 patent") and United States Patent No. 5,567,085 ("the '085 patent") (collectively, "the Bruckelmyer patents"). Bruckelmyer filed the application for the '085 patent on July 20, 1995; he filed the application for the '301 patent on July 17, 1996. The '301 patent is a continuation-in-part patent which is limited in term to the expiration date of the '085 patent.

Until 1999, Bruckelmyer had a series of license agreements with Defendant Ground Heaters, Inc. ("GHI"). Under the terms of the agreements, GHI was the exclusive licensee of the Bruckelmyer patents, although Bruckelmyer

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[1] Plaintiff's original motion also requested leave to amend the complaint and to add certain parties defendant. The Court directed the parties to submit those non-dispositive motions to the Magistrate Judge.

retained the right to license the patents to other entities if GHI failed to abide by its royalty obligations. The agreements also assigned responsibility for enforcing patent rights in the U.S. to GHI; Bruckelmyer was obligated to protect rights to the patents in Canada, although GHI was required to reimburse Bruckelmyer for any expenses he incurred doing so.

In late 1999, GHI brought suit in the Western District of Michigan against Defendant T.H.E. Machine Corporation ("Machine") for infringement of the Bruckelmyer patents (the "Michigan action"). In February of 1999, Machine answered GHI's Complaint and counterclaimed for declaratory judgment of noninfringement and invalidity of the Bruckelmyer patents. Machine also asserted that GHI lacked standing to bring suit to enforce patent rights still owned by Bruckelmyer.

In correspondence between counsel for Machine and then-counsel for Bruckelmyer, counsel for Machine requested that Bruckelmyer join the suit voluntarily. Counsel for Machine indicated its belief that GHI's rights in the patent were insufficient to confer standing and that Bruckelmyer was an indispensable party to the action. However, neither Machine nor GHI ever brought a motion to join Bruckelmyer as an indispensable or necessary party.

In the Michigan action, Machine asserted that the Bruckelmyer patents were invalid in light of prior art, specifically certain Canadian patents. Shortly after Machine filed a motion for summary judgment based on this argument, Machine and GHI began discussing terms of a possible settlement. GHI urged Bruckelmyer to agree to a lesser royalty from Machine. Although Bruckelmyer appears to have tentatively agreed to such an arrangement, he ultimately refused to accept a lesser royalty. Instead, on May 20, 1999, Bruckelmyer notified GHI that GHI was in default of the license agreement. Bruckelmyer cited past-due

royalties and amounts due for maintenance of the patents and indicated that GHI had 30 days to cure the default or the license would terminate in three months. GHI made no payments and, as a result, the license agreement terminated on August 20, 1999.

In September of 1999, GHT and Machine entered into a settlement agreement specifying that the parties agree that the Bruckelmyer patents are invalid. The Michigan court entered an order indicating that the parties had reached a settlement agreement and had stipulated to a dismissal of the action; the order dismissed the action with prejudice and without costs to either ply.

Bruckelmyer brought the instant action against both GHI and Machine alleging a variety of claims including infringement of the Bruckelmyer patents.

GHI and Machine assert, in the instant motion, that all claims of the Bruckelmyer patents are invalid as anticipated by Canadian Patent No. 1,158,119 ("the '119 Patent") and the accompanying application of that patent "the '119 Patent Application'").

Discussion

1. **Standard of Review**

Summary judgment is proper if there are no disputed issues of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. (:iv. P. 56(c). The court must view the evidence and the inferences which may be reasonably drawn from the evidence in the light most favorable to the nonmoving party. *Enterprise Bank v. Magna Bank of Missouri*, 92 F.3d 743, 747 (8" Cir. 1996). However, as the Supreme Court has stated, "[s]ummary judgment procedure is properly regarded not as a disfavored procedural shortcut, but rather as an integral part of the Federal Rules as a whole, which are designed `to secure the just, speedy, and inexpensive determination of every action.'"

Fed. R. Civ. P. 1. *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986).

The moving party bears the burden of showing that there is no genuine issue of material fact and that it is entitled to judgment as a matter of law. *Enterprise Bank*, 92 F.3d at 747. The nonmoving party must demonstrate the existence of specific facts in the record which create a genuine issue for trial. *Krenik v. County of Le Sueur*, 47 F.3d 953, 957 (8th Cir. 1995). A party opposing a properly supported motion for summary judgment may not rest upon mere allegations or denials, but must set forth specific facts showing that there is a genuine issue for trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256 (1986); *Krenik*, 47 F.3d at 957.

2. **Res Judicata**

Bruckelmyer asserts that the doctrine of res judicata should prohibit the Defendants from contesting the validity of the '301 patent and the '085 patent. Specifically, Bruckelmyer argues that both Defendants had the opportunity to litigate the validity of the patent in the Michigan action and cannot relitigate the issue in this forum. The Court disagrees.

The theory of res judicata[2] encompasses the closely related doctrines of claim preclusion and issue preclusion. The federal doctrine of claim preclusion prohibits relitigation of claims where: (1) a court of competent jurisdiction rendered the prior judgment; (2) the prior judgment was final and on the merits; and (3) both cases involved the same cause of action and the same parties. *See Canady v. Allstate Ins. Co.*, 282 F.3d 1005, 1014 (8th Cir. 2002). The doctrine

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[2] It is not entirely clear whether Bruckelmyer is asserting claim preclusion or issue preclusion. However, the result is the same regardless of which specific theory of res judicata Bruckelmyer is advancing.

of claim preclusion "is designed to prevent ... successive litigation. that allows second bites at the apple." *Sondel v. Northwest Airlines, Inc.*, 56 F.3d 934, 940 (8th Cir. 1995). Similarly, the doctrine of issue preclusion precludes relitigation of an identical issue if: (1) the issue was "actually litigated" in the first action; (2) the issue was essential to the judgment in the first action; and (3) the party against whom the doctrine is asserted had a full opportunity to litigate the issue in the original action. *See Masco Corp. v. U.S.*, 303 F.3d 1316, 1329 (Fed. Cir. 2002).

In their arguments on this issue, the parties devote considerable attention to the questions of whether the settlement of the Michigan action was a final judgment on the merits for purposes of applying the doctrine of claim preclusion, whether the settlement of the Michigan action constitutes "actual litigation" for purposes of applying the doctrine of issue preclusion, and whether Bruckelmyer can assert either type of preclusion when he was not a party to the Michigan action and thus cannot himself be bound by that litigation. While these questions are all relevant and even potentially dispositive of the issue at hand, the Court need not address them because another, more fundamental concern bars application of both claim and issue preclusion in this matter.

"The most purely public purpose served by res judicata lies in preserving the acceptability of judicial dispute resolution against the corrosive disrespect that would follow if the same matter were twice litigated to inconsistent results." Wright, Miller & Cooper, Federal Practice and Procedure: Jurisdiction 2d § 4403. The phrase itself, "res judicata," means "the thing has been adjudged." The issue has been decided, and the parties are bound by that decision. It would turn this policy on its head to apply the doctrine of res judicata so as to *create* inconsistent results, yet that is precisely what Bruckelmyer seeks to accomplish.

To the extent that the Michigan action resulted in a determination on the issue of validity that can be given preclusive effect as against the Defendants in this action, that determination was that the Bruckelmyer patents were *invalid*. Bruckelmyer, however, wants to employ the doctrine of res judicata to prevent the Defendants from asserting the patent's invalidity, and the result would be that this Court would be compelled to hold that the patents are, in fact, valid. The result is absurd and contravenes the very foundations of the doctrine of res judicata.

3. **Invalidity**

The first question the Court must address in ruling upon Defendants' Motion for Summary Judgment of Invalidity is whether the contents of the file wrapper of the '119 patent, which the Defendants refer to as the '119 patent application, constitute a printed publication for purposes of 35 U.S.C. § 102(6). The Court concludes that, as a matter of law, they do.

The question of whether a particular reference constitutes a "printed publication" for purposes of § 102(6) is a question of law based upon underlying questions of fact. *See In re Wyer*, 655 F2d 221, 227 (Cult. & Pat. App. 1981). The touchstone for determining whether a reference is a "printed publication" is whether it is accessible to interested members of the relevant public, and there is no need to show that particular members of the public actually received the information. *Id.*

The parties here agree that the contents of the file wrapper were available for public inspection at the Canadian Intellectual Property Office in Hull, Quebec, Canada. There is no contention that the contents of the file wrapper were disseminated more widely or in any other format. Nevertheless, the Court concludes that the contents of the file wrapper are sufficiently accessible to the relevant and interested public as to constitute a printed publication for

purposes of § 102(b). *See In re Hall*, 781 F.2d 897 (Fed. Cir. 1986) (a doctoral dissertation housed solely at Frieburg University in the Federal Republic of Germany was sufficiently accessible as to be a printed publication); *American Stock Exchange, LLC v. Mopex, Inc.*, 250 F. Supp. 2d 323 (S.D.N.Y. 2003) (an application housed solely in the Public Reference Room of the SEC was a printed publication, despite the SEC's lack of any subject matter index).

Having concluded that the '119 patent and the contents of its file wrapper constitute one or more prior art references, the Court then turns its consideration to whether said prior art references anticipate or render obvious the Bruckelmyer patents.

A patent issued by the U.S. Patent and Trademark Office is presumed valid. 35 U.S.C. § 282. To overcome that presumption, the Defendants must prow by clear and convincing evidence that the patent is invalid. *See Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1370 (Fed. Cir. 2002). "A determination that a patent is invalid as being anticipated under 35 U.S.C. § 102 requires a finding that 'each and every limitation is found either expressly or inherently in a single prior art reference.'" *Id. (quoting Celeritas Techs., Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir.1998)). "To anticipate, the reference must also enable one of skill in the art to make and use the claimed invention." *Id.*

On the face of the '119 patent, the device described is an invention for heating or thawing objects, specifically concrete during the curing process. Both the patent specification and the file wrapper contents indicate that the technology can also be used for thawing ground. Indeed, the file wrapper contents include a sketch of the device being used for the purpose of thawing the ground, and the sketch

seems to correspond in every way with the invention described in the Bruckelmyer patents.

However, the Court finds that there is a genuine issue of material fact regarding whether one of ordinary skill in the art would be enabled by the sketch or by the '119 patent itself to practice the technology described therein for the purpose of thawing ground.

This is not to suggest that the Court accepts Bruckelmyer's position that there is a vast technological or logical chasm between the '119 patent and his own invention. Rather, the Court's decision is premised upon the high burden the Defendants must carry in proving invalidity and upon the intensely factual nature of that determination. Indeed, the Court notes that the similarities between the '119 patent materials and the Bruckelmyer patents are remarkable, and they are unlikely to escape the notice of a jury. While the Court feels that the issue should be committed to a jury for ultimate determination, the Court cannot imagine that a jury will be likely to split the hairs that Bruckelmyer will ask it to. In short, as the Court frequently does, the Court urges the parties to consider carefully the difference between surviving a motion for summary judgment and prevailing at trial.

For the reasons stated, **IT IS HEREBY ORDERED:**

1. Plaintiff's Motion for Partial Summary Judgment (Doc. No. 42) is **DENIED**;

2. Plaintiffs' Motions for Summary Judgment of Invalidity (Doc. Nos. 44 and 49) are **DENIED**.

Dated: June 16, 2003

s/Donovan W. Frank
DONOVAN W. FRANK
Judge of United States District Court

UNITED STATES DISTRICT COURT

DISTRICT OF MINNESOTA

Mark Bruckelmyer,

Plaintiff,

v.

Ground Heaters, Inc., a Michigan corporation, and T.H.E. Machine Company, a Minnesota corporation,

Defendants,

and

T.H.E. Machine Company,

Counter-claimant,

v.

Mark Bruckelmyer,

Counter-defendant.

Civil No. 02-1761 (DWF/RLE)

MEMORANDUM OPINION AND ORDER

John B. Lunseth, II, Esq., David C. Forsberg, Esq., and Michael H. Streater, Esq., Briggs & Morgan; Kurt J. Niederluecke, Esq., Fredrikson & Byron; Lori J. Marco, Esq., Hormel Foods Corporation/Hormel LLC; Robert E. Lund, Esq., Medtronic, Inc., counsel for Plaintiff and Counter-defendant Mark Bruckelmyer.

James Moskal, Esq., Charles E. Burpee, Esq., and Douglas A. Dozeman, Esq., Warner Norcross & Judd; Michael John

Paper, Esq., Kinney & Lange, counsel for Defendant Ground Heaters, Inc., a Michigan corporation.

Randall T. Skaar, Esq., Eric H. Chadwick, Esq., and Aaron W. Davis, Esq., Patterson Thuente Skaar & Christensen PA, counsel for Defendant and Counter-claimant T.H.E. Machine Company, a Minnesota corporation.

Introduction

The above-entitled matter came for hearing before the undersigned United States District Judge on May 5, 2005, pursuant to a Motion for Summary Judgment of Invalidity brought by Defendant Ground Heaters, Inc. ("GHI"), and joined by Defendant and Counter-claimant T.H.E. Machine Company ("Machine"). For the reasons set forth below, Defendants' motion is granted. Background

Plaintiff Mark Bruckelmyer holds two United States patents for a "Method of Thawing Frozen Ground," United States Patent No. 5,820,301 ("the '301 patent") and United States Patent No. 5,567,085 ("the '085 patent") (collectively, "the Bruckelmyer patents").

Bruckelmyer filed the application for the '085 patent on July 20. 1995; he filed the application for the '301 patent on July 17, 1996. The '301 patent is a continuation-in-part patent which is limited in term to the expiration date of the '085 patent.

Until 1999, Bruckelmyer had a series of license agreements with GHI. Under the terms of the agreements, GHI was the exclusive licensee of the Bruckelmyer patents, although Bruckelmyer retained the right to license the patents to other entities if GHI failed to abide by its royalty obligations. The agreements also assigned responsibility for enforcing patent rights in the U.S. to GHI; Bruckelmyer was obligated to protect rights to the patents in Canada, although GHI was required to reimburse Bruckelmyer for any expenses he incurred doing so.

In late 1998, GHI brought suit in the Western District of Michigan against Defendant Machine for infringement of the Bruckelmyer patents (the "Michigan action"). In February of 1999, Machine answered GHI's Complaint and counterclaimed for declaratory judgment of noninfringement and invalidity of the Bruckelmyer patents. Machine also asserted that GHI lacked standing to bring suit to enforce patent rights still owned by Bruckelmyer.

In correspondence between counsel for Machine and then-counsel for Bruckelmyer, counsel for Machine requested that Bruckelmyer join the suit voluntarily. Counsel for Machine indicated its belief that GHI's rights in the patent were insufficient to confer standing and that Bruckelmyer was an indispensable party to the action. However, neither Machine nor GHI ever brought a motion to join Bruckelmyer as an indispensable or necessary party.

In the Michigan action, Machine asserted that the Bruckelmyer patents were invalid in light of prior art, specifically certain Canadian patents. Shortly after Machine filed a motion for summary judgment based on this argument, Machine and GHI began discussing terms of a possible settlement. GHI urged Bruckelmyer to agree to a lesser royalty from Machine. Although Bruckelmyer appears to have tentatively agreed to such an arrangement, he ultimately refused to accept a lesser royalty. Instead, on May 20, 1999, Bruckelmyer notified GHI that GHI was in default of the license agreement. Bruckelmyer cited past-due royalties and amounts due for maintenance of the patents and indicated that GHI had 30 days to cure the default or the license would terminate in three months. GHI made no payments and, as a result, the license agreement terminated on August 20, 1999.

In September of 1999, GHI and Machine entered into a settlement agreement specifying that the parties agree that the Bruckelmyer patents are invalid. The Michigan court

entered an order indicating that the parties had reached a settlement agreement and had stipulated to a dismissal of the action; the order dismissed the action with prejudice and without costs to either party.

Bruckelmyer then brought suit against both GHI and Machine alleging a variety of claims including infringement of the Bruckelmyer patents. GHI and Machine responded by bringing a Motion to Dismiss certain claims brought by Bruckelmyer asserting the Michigan court's dismissal of the suit barred Bruckelmyer from bringing the present action. This Court denied the Motion to Dismiss finding that GHI and Bruckelmyer were not in privity with regard to the Michigan action.

Bruckelmyer then moved for partial summary judgment. In response, GHI and Machine brought a Motion for Summary Judgment before this Court asserting that all of the claims of the Bruckelmyer patents were invalid as anticipated by Canadian Patent No. 1,158,119 ("the '119 Patent") and the accompanying patent application (the "119 Patent Application" or the "file wrapper of the '119 patent").

This Court found that, as a matter of law, the contents of the file wrapper of the '119 patent constituted a printed publication for purposes of 35 U.S.C. § 102(b). However, the Court found that there was a genuine issue of material fact regarding whether one of ordinary skill in the art would be enabled by the sketch, or by the '119 patent itself, to practice the technology described therein for the purpose of thawing ground. Thus, the Court denied Bruckelmyer's Motion for Partial Summary Judgment and the Motion for Summary Judgment of Invalidity brought by GHI and Machine.

On November 5, 2004, Bruckelmyer submitted a Stipulation for Entry of Judgment of Invalidity. On January 14, 2005, Bruckelmyer made a formal Motion for Entry of Judgment of Invalidity. GHI and Machine opposed the motion and the wording of the stipulation. The Court gave

the parties an opportunity to come to an agreement as to the stipulation's content. The parties were unable to do so. GHI then brought the Motion for Summary Judgment of Invalidity that is presently before this Court. Machine joined in the motion.

Discussion

I. Standard of Review

Summary judgment is proper if there are no disputed issues of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The court must view the evidence and the inferences which may be reasonably drawn from the evidence in the light most favorable to the nonmoving party. *Enterprise Bank v. Magna Bank of Missouri*, 92 F.3d 743, 747 (8th Cir. 1996). However, as the Supreme Court has stated, "[s]ummary judgment procedure is properly regarded not as a disfavored procedural shortcut, but rather as an integral part of the Federal Rules as a whole, which are designed 'to secure the just, speedy, and inexpensive determination of every action.'" Fed. R. Civ. P. 1. *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986).

The moving party bears the burden of showing that there is no genuine issue of material fact and that it is entitled to judgment as a matter of law. Enterprise Bank, 92 F.3d at 747. The nonmoving party must demonstrate the existence of specific facts in the record which create a genuine issue for trial. *Krenik v. County of Le Sueur*, 47 F.3d 953, 957 (8th Cir. 1995). A party opposing a properly supported motion for summary judgment may not rest upon mere allegations or denials, but must set forth specific facts showing that there is a genuine issue for trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256 (1986); *Krenik*, 47 F.3d at 957.

II. Motion for Summary Judgment of Invalidity

As previously stated, this Court found in its June 16, 2003, Order that as a matter of law the contents of the file wrapper of the '119 patent constituted a printed publication for purposes of 35 U.S.C. § 102(b). Based on that ruling, Bruckelmyer admits that:

> [I]f the contents of the file wrapper concerning the '119 Patent, excluding the '119 Patent itself, are considered to be printed publication as a matter of law, then the Bruckelmyer Patents are invalid due to the existence in the file wrapper of two drawing and accompanying written material which are prior art to Bruckelmyer's invention. Bruckelmyer does not admit that the '119 Patent is invalidating, whether the Patent is considered standing by itself or in any other way.

(Memorandum in Support of Stipulation and Motion for Entry of Judgment of Invalidity at 2.) GHI and Machine assert that Bruckelmyer's admission is a sufficient basis upon which to grant their Motion for Summary Judgment of Invalidity. The Court agrees. Accordingly, the Motion for Summary Judgment of Invalidity brought by GHI and Machine is granted.

For the reasons stated, **IT IS HEREBY ORDERED:**

1. The Motion for Summary Judgment of Invalidity brought by Defendant Ground Heaters, Inc. (Doc. No. 122) and joined by Defendant and Counter-claimant T.H.E. Machine Company (Doc. No. 125) is **GRANTED**.

2. The Motion for Summary Judgment of Invalidity (Doc. No. 112) brought by Plaintiff and Counter-defendant Mark Bruckelmyer is **GRANTED**.

LET JUDGMENT BE ENTERED ACCORDINGLY.

Dated: May 13, 2005

s/Donovan W. Frank
DONOVAN W. FRANK
Judge of United States District Court

OPPOSITION BRIEF

Supreme Court, U.S.
FILED
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No. 06-443

In the Supreme Court of the United States

MARK BRUCKELMYER,

Petitioner,

v.

T.H.E. MACHINE COMPANY,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

RESPONDENT'S OPPOSITION TO PETITIONER'S PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

T.H.E. Machine Company will address the following questions:

1. Whether this case rises to the level of importance meriting review by the Court.

2. Whether the prior art document at issue falls within the meaning of "printed publication" under 35 U.S.C. § 102(b).

3. Whether there is any merit to any of Petitioner Mark Bruckelmyer's other arguments for review on certiorari.

LIST OF PARTIES AND CORPORATE DISCLOSURE STATEMENT

Bruckelmyer correctly lists the parties to the proceedings; however, T.H.E. Machine Company is in agreement with Ground Heaters that Bruckelmyer incorrectly states that Ground Heaters has no interest in the outcome of the petition.

T.H.E. Machine Company has no parent corporation. No publicly held company owns 10% or more of T.H.E. Machine Company's stock.

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STATUTES

35 U.S.C. § 102(b) 2, 4, 5, 7, 8, 9, 11

STATEMENT OF THE CASE

The Federal Circuit has outlined the basic facts of this dispute. Bruckelmyer Appendix at 1a-5a. To recap, Mark Bruckelmyer's ("Bruckelmyer") petition centers around one piece of prior art, namely a file wrapper to a Canadian patent that issued to Norman Young in 1983. The facts related to that file wrapper are undisputed. On May 7, 1982, Norman C. Young ("Young") applied for a patent in Canada regarding a portable heating system that places flexible hoses "in close proximity to objects of various shapes and configurations which would otherwise be difficult to heat." Bruckelmyer Appendix at 3a. Like the methods claimed in the patents in suit, Young's system was "suitable for applying heat to other subjects," including as "[o]ther typical uses...thawing frozen ground." *Id.* Ultimately, Canadian Patent No. 1,158,119 ("the '119 Patent") issued to Young on December 6, 1983. *Id.* It is undisputed that the accompanying file history ("the '119 File Wrapper") was laid open and made available to the public on or about December 6, 1983 as well. *Id.* at 6a.

The '119 File Wrapper contained two figures, Nos. 3 and 4, that were not included in the '119 Patent itself. Bruckelmyer Appendix at 3a-4a. Bruckelmyer has conceded (a) that these two figures are contained in the '119 File Wrapper, (b) that these figures invalidate the two Bruckelmyer patents in suit if the ruling of the district court that the '119 File Wrapper is a "printed publication" is affirmed, and (c) that the '119 File Wrapper was available for public inspection at the Canadian Intellectual Property Office prior to the critical date of Bruckelmyer's patents. *Id.* at 3a-6a.

On April 20, 2006, the Federal Circuit upheld a finding of the United States District Court for the District of Minnesota that Bruckelmyer's patents were invalid under 35 U.S.C. § 102(b) because they were anticipated by the file history of the '119 File Wrapper. Bruckelmyer Appendix at 2a-10a. No facts relating to the availability of the '119 File Wrapper were in dispute, so the only question for the Federal Circuit to decide was whether or not as a matter of law the

file wrapper constituted a printed publication. *Id.* at 5a. The Federal Circuit held that it was a printed publication, because the file wrapper was "publicly accessible" in that a person of ordinary skill in the art interested in the subject matter of the patents in suit exercising reasonable diligence would have been able to locate it. *Id.* at 7a-10a. The court held that no reasonable trier of fact could have found that the '119 Patent did not provide sufficient information to allow a person of ordinary skill in the art to locate the '119 File Wrapper. *Id.* at 9a. Bruckelmyer's subsequent combined request for a panel rehearing and rehearing en banc was denied. *Id.* at 15a.

In September 2006, Bruckelmyer filed his Petition for Writ of Certiorari. In October 2006, Ground Heaters, Inc. ("Ground Heaters") filed a motion for leave to file amicus curiae brief and the brief in opposition to Bruckelmyer's petition. Respondent T.H.E. Machine Company joins in Ground Heaters' arguments and factual assertions made in its *Amicus Curiae* Brief and incorporates them in their entirety into this opposition. Accordingly, T.H.E. Machine Company

will not repeat all of those arguments in this brief, but instead focuses on additional reasons for the denial of Bruckelmyer's petition.

REASONS FOR DENYING THE WRIT

I. THIS CASE IS A FACT-SPECIFIC CASE WITH NO JURISPRUDENTIAL SIGNIFICANCE.

As noted by Ground Heaters in its *Amicus Curiae* Brief, this case has no jurisprudential significance. None of the limited reasons outlined for review on certiorari are present here. The Court of Appeals for the Federal Circuit has decided an issue of patent law, whether or not the '119 File Wrapper is a "printed publication" under 35 U.S.C. § 102(b), that is perfectly consistent with the prior rulings of the Federal Circuit on the meaning of "printed publication." Bruckelmyer has not identified any Federal Circuit decisions that conflict with that court's opinion in this case. Nor has Bruckelmyer contended that the Federal Circuit's decision in this case conflicts with any other United States court of appeals' decisions or with any opinions of this Court.

Instead, Bruckelmyer contends that this Court should "settle" the legal determination of what constitutes a "printed publication" under 35 U.S.C. § 102(b). But Bruckelmyer fails to illustrate how the law is unsettled, as he alleges, on this issue of patent law.

Bruckelmyer points to the two-judge dissent in the Federal Circuit's opinion in an effort to show some kind of dispute within the Federal Circuit that should be resolved by this Court. As Ground Heaters notes, however, the Federal Circuit does not disagree on the legal standard for what constitutes a "printed publication" under 35 U.S.C. § 102(b). The dissenting judges simply took issue with the legal conclusion drawn by the majority under this case's specific facts. Just because two of the twelve Federal Circuit judges dissented does not necessitate that the law is therefore "unsettled and in dispute," as Bruckelmyer contends. The District of Minnesota and the vast majority of the Federal Circuit, applying the correct legal standard, agreed that the

undisputed facts warranted affirmance of the conclusion that the '119 File Wrapper is a "printed publication."

As Bruckelmyer put it, this case involved a file wrapper that is "unorthodox," (Petition at 3) and, as Ground Heaters put it, "a unique set of facts." (*Amicus Curiae* Brief at 5). Even the dissenting Federal Circuit judges did not dispute that the district court and the Federal Circuit applied the correct law. No far-reaching policy issues or groundbreaking problems were decided here. This is not the type of dispute that deserves this Court's review.

Moreover, Bruckelmyer's "unsettled law" and "judicial rewriting of the law" arguments that were made in his petition were raised for the first time in his combined petition for panel rehearing and rehearing en banc. These issues were not raised by Bruckelmyer in his substantive appeal to the Federal Circuit; he did not raise them at the district court either. As such, Bruckelmyer has waived these arguments. *See Pentax Corp. v. Robison*, 135 F.3d 760, 762 (Fed. Cir. 1998) ("Just as this court will not address issues

raised for the first time on appeal or issues not presented on appeal, we decline to address the … new theory raised for the first time in its petition for rehearing."); *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1426 (Fed. Cir. 1997) ("appellate courts do not consider a party's new theories, lodged first on appeal"); *Clingman v. Beaver*, 544 U.S. 581, 597-98 (2005).

II. THE '119 FILE WRAPPER WAS PROPERLY RECOGNIZED BY THE FEDERAL CIRCUIT AS A "PRINTED PUBLICATION."

Notwithstanding the fact that this case is inappropriate for review on certiorari, the '119 File Wrapper plainly satisfies the meaning of "printed publication" under 35 U.S.C. § 102(b). A patent is invalid if "the invention was patented or described in a printed publication in this or a foreign country...more than one year prior to the date of application for the patent in the United States." 35 U.S.C. § 102(b). Section 102(b) "was designed to prevent withdrawal by an inventor, as the subject of a patent, of that which was already in the possession of the public." *In re Cronyn*, 890 F.2d

1158, 1160 (Fed. Cir. 1989) (*quoting In re Wyer*, 655 F.2d 221, 226 (C.C.P.A. 1981)). "Where there are no disputed factual issues, the question [of] whether particular material is a 'printed publication' is a question of law." *In re Cronyn*, 890 F.2d at 1159. As noted above, in this case, there were no disputed issues of fact, so the question readily became purely a legal determination. *See* Bruckelmyer Appendix at 5a, 8a.

A reference that describes an invention is a "printed publication" under §102(b):

> Upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it ....

In re Wyer, 655 F.2d at 226. "The statutory phrase 'printed publication' has been interpreted to mean that before the critical date the reference must have been sufficiently accessible to the public interested in the art." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed. Cir. 1988). Placing the material in a location where it is

readily accessible to the interested public – whether or not it is disseminated further – is a "publication" under the statute. *See In re Hall*, 781 F.2d 897 (Fed. Cir. 1986) and *in re Wyer*.

It is undisputed that the '119 File Wrapper contains the material that invalidates Bruckelmyer's patents and that this information was made available to the public over 10 years before Bruckelmyer even filed the applications for his two patents. Petition at 2-3. Moreover, Bruckelmyer concedes that the invalidating material is readily available at the Canadian Intellectual Property Office and that, in fact, he obtained a certified copy of the file wrapper. *Id.* Indeed, all of the parties to this case have obtained a copy of the '119 File Wrapper without any difficulty. These undisputed facts satisfy the "printed publication" standard of 102(b) – namely, that the '119 File Wrapper has been publicly available at the Canadian Intellectual Property Office since 1983 and that the material contained in the file wrapper invalidates Bruckelmyer's patents.

III. BRUCKELMYER'S PROTESTATIONS FOCUS ON ISSUES THAT ARE IRRELEVANT TO WHETHER THE '119 FILE WRAPPER IS A "PRINTED PUBLICATION."

Nonetheless, in his petition, again Bruckelmyer loses sight of the actual standard under which the Federal Circuit was to decide whether or not the '119 File Wrapper is a printed publication. The sole question for the Federal Circuit to decide was "whether a person of ordinary skill in the art interested in the subject matter of the patents in suit and exercising reasonable diligence would have been able to locate the '119 application." Bruckelmyer Appendix at 8a. In his petition, Bruckelmyer ignores this standard and instead marches forth numerous arguments that have no actual bearing on the issue at hand.

Bruckelmyer argues at length about the supposed meaning of "printed publication" and what technology it encompasses. These arguments, however, are irrelevant, because, as Bruckelmyer concedes, copies of the '119 File Wrapper are available for review and purchase by members

of the public at the Canadian Intellectual Property Office and have been so since the issuance of the '119 Patent in 1983. Bruckelmyer also concedes that the '119 Patent was printed and published.[1] That fact lead the Federal Circuit to conclude that the '119 File Wrapper was sufficiently accessible to the public, because the very invalidating process contained in the file wrapper was referenced in the '119 Patent itself.

In sum, both the patent and the file wrapper were publicly accessible and copies were available long before Bruckelmyer filed his patent applications. Accordingly, the Federal Circuit properly found that "it does not matter that [the invalidating material] do[es] not appear in the '119 patent because no reasonable trier of fact could find that there was not sufficient disclosure in the patent to allow one skilled in the art to locate the [invalidating material] contained in the application." Bruckelmyer Appendix at 10a. In his petition, Bruckelmyer contests that conclusion, stating that there is no

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[1] Issued foreign patents are also specifically identified as potentially invalidating prior art under 35 U.S.C. § 102(b).

evidence, such as witness testimony, on whether a patent searcher would be able to locate the invalidating material. Petition at 17-18, n.5. However, Bruckelmyer specifically waived this objection at the Federal Circuit oral argument when he conceded that no such evidence would be needed to decide the issue of whether the '119 File Wrapper is a "printed publication."[2]

CONCLUSION

Bruckelmyer complains that the Federal Circuit has impermissibly rewritten the patent statute for Congress. The real issue is that Bruckelmyer did not invent the methods claimed in his patents and the proof of that fact was contained in a publicly available file wrapper of an issued Canadian patent. Moreover, the issued patent specifically referenced the invalidating method, which was addressed in more detail in the file wrapper. The patent and its file wrapper were indexed and stored together, publicly available and

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[2] *See* http://www.cafc.uscourts.gov/oralarguments/mp3/05-1412.mp3, at 29:59 – 30:42.

accessible, and were in fact located and obtained by every party to this case. Simply put, the United States government is not in the business of handing out patents for inventions that have been in the public domain for over 10 years prior to a patent application being filed. The Court should decline Bruckelmyer's invitation to do so in this case. Based on the foregoing reasons and those outlined in Ground Heaters' *Amicus Curiae* Brief, Bruckelmyer's Petition for Writ of Certiorari should be denied in its entirety.

November, 2006

Respectfully submitted,

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